

REMARKS

Claims 1-8, 17-20 and 38 remain rejected under 35 USC 103(a) as being unpatentable over Paoletti in view of Ramshaw. This rejection is respectfully traversed. The pending claims all recite an avipox viral vector incorporating HIV Gag and/or Pol or derivatives thereof and a second nucleic acid molecule encoding γ -interferon. The Examiner states that Paoletti provides "avipox viral vectors (e.g., TROVAC, ALVAC) encoding lentiviral (e.g. HIV, SIV) gene products (e.g., Gag, Pol, Env) that are suitable for inducing viral-specific immune responses." However, the Examiner admits that Paoletti fails to disclose using the avipox viral vector incorporating an HIV antigen with a cytokine.

According to the Examiner, Ramshaw provides recombinant viral vectors carrying a first nucleic acid encoding a viral immunogen and a second nucleic acid encoding a cytokine adjuvant that facilitates the immune response to the immunogen. It is the Examiner's contention that it would have been obvious to combine the avipox viral vector disclosed in Paoletti with the cytokine disclosed in Ramshaw. The Examiner contends that it would be reasonable to make the combination "since this would reasonably be expected to enhance the immune response to the HIV-1 antigen of interest."

As previously explained in the amendment filed on June 15, 2004, the Examiner's assertion that cytokines could reasonably be expected to enhance the immune response of the antigen of interest is not supported by the record since the Examiner has pointed to no disclosure in either Paoletti or Ramshaw to support the specific combination of the claimed cytokine and HIV antigens.

The Examiner has maintained the rejection of the claims as obvious over Paoletti in view of Ramshaw without providing any evidence on the record to support the specifically claimed combination. The Examiner simply states that "... there would have been more than sufficient motivation to modify the compositions of Paolette et al. (1998), to include a second nucleic acid

encoding a cytokine adjuvant as taught by Ramshaw et al. (1999), since this would reasonably be expected to enhance the immune response to the HIV-1 antigen of interest.”

As explained by the Federal Circuit in *Life Technologies, Inc. v. Clontech*, 224 F.3d 1320, 1326, 56 USPQ2d 1186, 1191 (2000), it is impermissible to use “the inventors” success as evidence that the success would have been expected.” Since the cited references do not mention the specifically claimed combination, the motivation to combine the claimed compositions only becomes obvious after reading applicants’ specification. This represents the impermissible use of hindsight.

In addition, the fields of HIV treatments and vaccinations are littered with a huge variety of compounds and formulas. As explained by the Federal Circuit in *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (1988), “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” Since the prior art does not describe the specific combination of γ -interferon and the claimed HIV antigens, the assertion that it would be obvious to one of ordinary skill in the art to pick and choose these specific components from the huge variety of compounds available can only be based on the impermissible use of hindsight.

Since the rejection of claims 1-8, 17-20 and 38 as being unpatentable over Paoletti in view of Ramshaw is based on the impermissible use of hindsight, this rejection should be withdrawn.

Claims 9-16 and 21-35 stand rejected under 35 USC 112, first paragraph, as lacking enablement. Applicants have deleted the claims which the Examiner has rejected as lacking enablement. Further, the remaining claims have been amended to specifically refer to gag/pole as the subject HIV-1 antigen and interferon- γ as the cytokine. These amendments render the enablement rejection moot.

In view of the above, each of the presently pending claims in this application is in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Attorney Docket No. 229752001400.

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Respectfully submitted,

By


Jonathan Bockman

Registration No.: 45,640

MORRISON & FOERSTER LLP

1650 Tysons Blvd, Suite 300

McLean, Virginia 22102

(703) 760-7769